APPENDIX.

Containing RS4887
and
Certificate of Clerk
of
United States Circuit
Court of Appeals for the
Third Circuit
as to
"Questions Involved"

APPENDIX.

RS4887

(35 USC § 32)

(as it was in 1920-1936)

"§ 32. *Inventions previously patented abroad.* No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for a patent for for the the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more

than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R. S. § 4887; Mar. 3, 1897, c. 391, § 3, 29 Stat. 693; Mar. 3, 1903, c. 1019, § 1, 32 Stat. 1225.)"

CLERK'S CERTIFICATE.

UNITED STATES OF AMERICA,
EASTERN DISTRICT OF PENNSYLVANIA, } *Sct.*
THIRD JUDICIAL CIRCUIT,

I, WILLIAM P. ROWLAND, Clerk of the United States Circuit Court of Appeals for the Third Circuit, do hereby certify:

That the rules of said United States Circuit Court of Appeals for the Third Circuit, effective March 1, 1940, and at all times since in force, contain, *inter alia,* the following provisions:

> "Assignments of errors shall not be required except in appeals in criminal cases." (Rule 14 1.)
>
> "The brief of the appellant or petitioner shall contain the following matter under distinctive titles, arranged in the following order:
>
> "* * *
>
> "(b) A statement of the questions involved, setting forth each question separately, * * * ordinarily no point will be considered which is not set forth in or necessarily suggested by the statement of questions involved." (Rule 26 3.)

That the following is a true and faithful copy of the "Questions Involved" as stated pursuant to the foregoing Rule, 26 3 (b), by defendant-appellant in the case of The Electric Storage Battery Company, defendant-appellant v. Genzo Shimadzu and Northeastern Engineering Corporation, plaintiffs-appellees, No. 7602, October Term 1940, in the said United States Court of Appeals for the Third Circuit, as the same appear in the brief of said The Electric Storage Battery Company on file, and now remaining among the records of the said Court, in my office:

> "I. Are not both claims of patent 1,584,149, invalid,

(a) under R. S. 4887 by reason of Japanese patents 41,728 and 42,563 to Shimadzu;

(b) for want of utility;

(c) for want of invention;

(d) because the amendment to the application changing the revolutions of the mill from 15-25 per *hour* to 15-25 per *minute* was made January 4, 1926 and without supplemental oath?

II. Does not the law of the case as well as the patent, prevent reading into patent '149 the oxidation and controlled elevated temperature of patent '150?

III. Were oxidation and controlled temperature now to be read into patent '149 would it not be invalid,

(a) under R. S. 4888 for inadequate disclosure;

(b) because of defendant's prior commercial public use thereof in its Tudor mill operations?

IV. Does defendant's process infringe patent '149?

V. Because of their laches, are plaintiffs not barred from all relief?''

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the said Court, at Philadelphia, this 4th day of March, in the Year of our Lord one thousand nine hundred and forty-two and of the Independence of the United States one hundred and sixty-six.

(Seal)

Wm. P. Rowland,
Clerk of the U. S. Circuit Court of Appeals, Third Circuit.

(The original of the foregoing Certificate has been lodged with the Clerk of the Supreme Court of the United States.)